

Remarks:

In the July 6, 2004, Claims 18 and 19 were rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 2, 7, and 11-19 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Chang (U.S. Patent No. 5,848,400). Claims 3-6 and 8-10 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Chang.

Claims 18 and 19 have been amended in this Amendment A to correct the Section 112 issue pointed out by the Examiner. The Examiner's assistance in noting these errors is greatly appreciated by the Applicant.

Applicant's invention is directed to an electronic bill presentment and payment ("EBPP") system in which by processing bill payments made by customers to a biller, a service provider can data mine the payments to obtain information which will allow electronic bills to be presented directly to the customers through the customers' banks in the future. This is accomplished even though the customers have not signed up for bill presentment.

The Chang reference (U.S. Patent No. 5,848,400), on the other hand, teaches a high level banking system in which servers are used by banks to perform electronic payments and to send bills. There is not a single word in the entire Chang reference which teaches or suggests obtaining information on customers through the processing of

payments from them to enable the presentment of bills to such customers. In the July 6, 2004, Office Action, the Examiner has glossed over the limitations in the claims which require such activity and are clearly not taught by Chang.

In particular, independent Claims 1, 18, and 19 were all rejected under Section 102, which requires that each and every limitation of the claims be taught by the cited reference. With regard to Claim 1, nothing in the Chang reference teaches the entire step of "obtaining a plurality of bill files..." The Examiner refers to Col. 4, lines 15-18 and lines 60-65. This is quite simply incorrect. Lines 15-18 do not refer at all to information on bill files, but rather refer to electronic checks or credits, which have nothing whatsoever to do with obtaining bill files, which in and of itself has nothing to do with electronic checks or credits. This step is performed in Chang by the payment processor 228, which is merely accomplishing the electronic transfer of funds. Lines 60-65 refers to a process of inter-regional bank transfers of electronic bills, and does not in any way accomplish what the quite explicit words of the step of "obtaining a plurality of bill files..." in Claim 1 requires. Not only is there no anticipation of this element, there is most certainly no teaching or suggestion of anything remotely similar.

There are several sub-steps which are contained under the "processing records in each bill file..." step. The Examiner refers to column 4, line 60 to column 5, line 18 of Chang, which talks about forwarding bills to the banks of the customers. The step of "obtaining a routing address..." is never performed by Chang, since in Chang the bills

themselves contain this information, enabling the transferring bank to transfer the bills. Transfer is an apt word, since once transferred, the transferring bank never sees them again, which is completely and totally unlike the present invention which clearly states that the bills are presented to the customers rather than merely being transferred.

The other limitations in this step, namely "obtaining customer account identification information..." and "assembling a bill packet..." are also not performed by Chang, which simply transfers the bills to the customers' banks.

The steps of "sorting the received bill packets..." and "assembling a bill presentation file..." are also never performed by Chang. In Chang, the bill packets, to the extent that one may argue that they even exist, are sent to the customers' banks, and then are never seen again. The sorting and assembling steps which take place after the transmitting step are neither contemplated nor suggested by Chang, far less specifically taught are required by Section 102. Finally, the "electronically presenting..." step is not performed by the service provider at all in Chang, but rather is performed by the customer's banks.

Thus, it is readily evident that the Chang reference is a square hole into which the Examiner has attempted to pound the round peg which is Claim 1. Thus, it is evident that Claim 1 is neither taught nor suggested by the Chang reference, which is not relevant to the present invention. Thus, Applicant submits that Claim 1 is patentable over the Chang reference, and the Section 102 rejection is improper and must be removed.

Claims 2 through 17, which depend from Claim 1, are also patentable in view of the patentability of Claim 1, and no further arguments with regard to these claims is believed to be required.


Claim 18 contains the limitations of Claim 1, plus several additional limitations, and is similarly patentable over Chang for all of the same reasons. Additionally, Claim 18 also recites an "obtaining payments..." step which is neither taught nor suggested by Chang. Claim 19 contains, in combination, the "obtaining a payment..." step and the "data mining..." step which are not taught in combination by the Chang reference, and Claim 19 is also thereby patentable over the Chang reference.

Accordingly, Applicant believes that Claims 1-19 are patentable at this time. These claims remain pending following entry of this Amendment A, and are in condition for allowance at this time. As such, Applicant respectfully requests entry of the present Amendment A and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the

application could be expedited, the Examiner is requested to call Applicant's undersigned attorney at the number listed below.

Respectfully submitted:

BY



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